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| 10/560,000 | 12/09/2005 | Ryoichi Matsuoka | 0080-0240PUS1 | 4598 |
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| BIRCH STEWART KOLASCH & BIRCH | | | EXAMINER | |
| PO BOX 747 | | | ROBINSON, LAUREN E | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | |
|------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/560,000 | Applicant(s) MATSUOKA, RYOICHI |
| | Examiner LAUREN ROBINSON | Art Unit 1794 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 12 May 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 8-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 December 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-166/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 10 are rejected due to both reciting:

"...bifurcate pin member having two pin tips onto a bottom part of said root portion pot to an upper part of the root portion of said imitation lawn **forcibly fit in the root portion**...such that said pin member traverses a middle portion of the root portion, from which said foliaceous pieces are parted, **and strides across both sides of an opening of said root portion pot.**"

The manner in which these claims are written is unclear due to it not being known whether the pin member or the imitation lawn is forcibly fit, and whether the two pin tips or the parted foliaceous pieces stride across both sides of an opening of said root portion pot. For applying prior art, the examiner interprets the claims to mean that the imitation lawn is forcibly fit and the pin member strides across both sides of an opening.

Claims 9 and 11-13 are rejected based on being dependent of claims 8 and 10 which are rejected above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-13 are rejected under 35 U.S.C. 103(a) as being obvious over Yamada (JP 11-113724).

Regarding claims 8 and 10: Yamada teaches an artificial lawn comprised of a synthetic resin lawn (imitation lawn), a base mat (laying board) onto which the imitation lawn is planted (abstract and Figures). Also, the imitation lawn is actually a bunch of resin filaments which are representative of leaves (foliaceous pieces) (abstract and Figures) and a planting hole “5” (root portion pot) which bundles the bunch of foliaceous pieces (Figures).

The examiner notes that claims 8 and 10 are product by process claims due to both claims reciting the limitations of:

“...imitation lawn being fixed to said laying board by driving a bifurcate pin member ... onto a bottom part of said root portion pot”,

“...guide grooves, upon driving of said bifurcate pin member onto the bottom part of said root portion pot, specifying drive positions of both the pin tips... and also guiding both pin tips...”,

and claim 10 recites “guide grooves, upon driving of said bifurcate pin member onto the bottom part of said root portion pot, specifying drive positions of both the pin

tips and guiding a striking tool used for driving said bifurcate pin member to the bottom part of said root portion pot".

According to the MPEP 2113 [R-1], product-by-process claims are limited by and defined by the process and determination of patentability is based on the product itself and not its method of production. Therefore, if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding the first product by process limitation, Yamada teaches that the imitation lawn is forcibly fit into the planting hole (abstract) and is fixed to the base mat by driving a bifurcate band member having two tips onto a bottom part of the planting hole to an upper part of the root portion of said imitation lawn (Figures). The examiner notes that a pin is broadly defined as a piece of material that fastens things together (Merriam-Webster, <http://www.merriam-webster.com/cgi-bin/dictionary?book=Dictionary&va=pin>). Therefore, the above bifurcate band is considered a pin.

The imitation lawn and pin are forcibly fit in the planting hole of the base mat such that the above pin traverses a middle part of the lawn root portion, from which the foliaceous pieces are parted and the pin and parted foliaceous pieces stride across both sides of the planting hole opening (Figures 2 and 5). Also, the reference teaches that the base mat has a pair of guide grooves formed in the peripheral wall part of the planting hole and these grooves are represented by 11 in the figures while the planting

hole is represented by 5. From this illustration, it is seen that these grooves are at positions opposing each other through the opening of the planting hole.

Regarding the second product by process limitation, the reference teaches that the pin is driven into the planting hole (Figures and Par. 0009) and upon forming the lawn, the grooves expand (Par. 0019). From the illustrations and this teaching, it is seen that the guide grooves inherently expand upon the driving of the pin member and guide the pin onto the bottom portion of the planting hole, specifying drive position of both pin tips and guiding the pin tips to the bottom of the planting hole. Further, the illustrations show that the inner diameter of the planting hole 5 is narrower than a horizontal distance between the pin tips of the pin member and the grooves 11, are recesses in the peripheral wall of hole 5 wherein the recesses extend in a vertical direction and through said base mat. Also, from the illustrations, the pair of guide grooves is formed so as to reach depth wise to the bottom part of the planting hole.

Furthermore, regarding the last product by process limitation of claim 10, the illustrations show and it was discussed that the guide grooves would inherently guide the pin member upon driving and specify drive positions of both pin tips of said pin member. Also, the illustrations represent that the pin member is inserted into the planting hole and the examiner notes that the pin would inherently have to be inserted with a striking tool such as a hand, etc. in order to be inserted. Further, since the pin is guided and placed in positions based on the guide grooves, then the guide grooves would also inherently have to guide whatever tool was used to insert said pins since the

pin is inserted using a striking tool and while inserted using said tool, the guide grooves are guiding the pin and therefore, the tool as well.

However, the reference is *silent regarding a plurality of imitation lawns each comprising a bunch of the above foliaceous pieces and planting holes.*

Consider a plurality of imitation lawns each comprising a bunch of the above foliaceous pieces and planting holes.

While the reference does disclose that there are a plurality of the imitation lawns comprising the bundles and planting holes are on the base mat, they teach that lawns used in the above manner are advantageous for a yard, etc. (Par. 0001) and while the reference only specifically discloses one imitation lawn on the base mat to form the artificial lawn and method of producing said lawn, one of ordinary skill in the art would recognize that in order to provide more coverage and a larger artificial lawn surface, that a plurality of the above imitation lawn bundles with the planting holes could be used on the base mat. Also, this concept of providing a plurality of bundles to a base mat to produce an artificial lawn type material is evidenced by Salle (US PN. 5,976,643) as being known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Yamada to include that a plurality of the imitation lawns each comprising the bundles and planting hole can be applied to the base mat in order to provide more uniform and complete coverage when producing an artificial lawn for a yard, etc. (**Claims 8 and 10**).

Regarding claims 9 and 11: The reference also teaches as illustrated by the illustrations that both pin tips of the pin member pierce through the bottom part of the

planting hold of the base mat and can be folded back. Also, when folded, the pin tips can be in contact with a bottom surface of the planting hole of the base mat wherein both pin tips are facing each other (Figure 5) (**Claims 9 and 11**).

Regarding claims 12-13: The examiner notes that claims 12 and 13 are also product by process claims and the same rules from above apply due to the claims reciting:
"...each of the guide grooves is non-movable with respect to said laying board upon the driving of said bifurcate pin member onto the bottom part of said root portion pot."

The manner in which the claim is written reads that the guide grooves don't move during the process of driving the pin member into the bottom portion. Therefore, in these claims, the grooves being non-movable during the process is the process limitation of the claims and the product itself only needs non-movable grooves within the final product post production. Therefore, regardless of if the grooves move during the driving process, as long as the grooves are non-movable in the prior art final product, the applicants' product is taught and unpatentable.

In the instant case, the reference does not teach that the guide grooves do not move when the pin is inserted but rather expand during insertion. However, the overall structure is taught and as illustrated in the Figures, the grooves are stationary (non-movable) with respect to the base mat. While, the process is not taught, the examiner notes that one of ordinary skill in the art would recognize that whether or not the guide grooves move during manufacture, the finished product will be the same and any method including the applicants' claimed process can be used. As such, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify

Yamada to include that the method of producing the artificial lawn can include that the guide grooves do not move upon insertion of the pin into the bottom portion of the planting hole (**Claims 12-13**).

Response to Arguments

Applicant's arguments with respect to claims 8-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAUREN ROBINSON whose telephone number is (571)270-3474. The examiner can normally be reached on Monday to Thursday 6am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-2721284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lauren E. T. Robinson
Examiner
AU 1794

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